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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,117	08/09/2001	Robert Briggs Phillips	VTN-0549	2698

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EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,117

Applicant(s)

PHILLIPS ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 21 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This Office action acknowledges the applicant's amendment presented as Paper No. 7. Claims 1-22 are pending in the application.

Specification

2. The abstract of the disclosure is objected to because the abstract contains the legal phraseology "said" in reference to components. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-7 and 10-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (US 6,082,533).

Regarding claim 1, Smith et al discloses (Figures 5 and 6) a disposable contact lens package (300) with a raised seal volume (310), base (312), top surface (371), perimeter top surface (370), and recessed well (314). Package (300) is sealed with lidstock (Col. 3, ll. 4-9). Smith et al discloses raised surface (310) as arcuate in shape to prevent the collection of aqueous fluid on its surface (Col. 3, ll. 9-12). Smith et al discloses the claimed invention except for two linear sides intersecting the horizontal plane at angles having values from 125 to 170 degrees.

Smith et al further discloses an alternate embodiment (200) with a linear side (220) having an angle greater than or equal to 90 degrees (Col. 2, ll. 38-42) instead of an arcuate side. Smith et al shows that linear sides are an equivalent structure known in the art with respect to the movement of fluids from the top surface of a raised volume. Therefore, because these two geometric configurations were art recognized equivalents

at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute linear sides for arcuate sides.

As to the angles having values from 125 to 170 degrees, Smith et al discloses linear sides with angles greater than or equal to 90 degrees (encompassing the range of angles from 125 to 170 degrees) and therefore discloses the claimed invention except for expressly disclosing angles from 125 to 170 degrees. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package (Smith et al, 300 with linear sides substituted for arcuate sides) with angles from 125 to 170 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

As to claims 2, 3, 5-7, and 10-17, the package (Smith et al, 300 with linear sides substituted for arcuate sides) as applied to claim 1 above discloses the claimed invention except for the specific dimensions claimed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Smith et al with dimensions as claimed by the applicant, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

As to claim 4, Smith et al discloses raised seal volume (310) located 0.2 mm from the perimeter of the well (Col. 2, ll. 66-67).

As to claims 18 and 22, Smith et al discloses rounded surfaces (260, 360) at the peak of the raised seal volume. It would have been obvious to one of ordinary skill in

the art at the time the invention was made to include this feature in the package (Smith et al, 300 with linear sides substituted for arcuate sides) in order to maintain the fluid dispersing properties of the raised seal volume.

As to claims 19-21, the package (Smith et al, 300 with linear sides substituted for arcuate sides) as applied to claims 1, 17, and 18 above discloses the claimed inventions except for the specific radii claimed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Smith et al with radii as claimed by the applicant, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

4. Claims 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al as applied to claims 1 and 6 above, and further in view of Lust et al (5,704,468) and Abrams et al (US 5,467,868).

The package (Smith et al, 300 with linear sides substituted for arcuate sides) as applied to claims 1 and 6 above discloses the claimed inventions except for the specific distances claimed by the applicant. Lust et al (Figures 4, 8, and 13) and Abrams et al (Figure 3) disclose that it is known in the art to place the raised seal volume at a distance from the perimeter of the well. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Smith et al with distances as claimed by the applicant, since it has been held that discovering an

optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

5. Applicant's arguments, see page 6, last paragraph, continued on page 7, and page 8, first complete paragraph, filed January 21, 2003, with respect to the rejection(s) of claim(s) 1-20 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a different interpretation of the previously applied Smith et al reference and newly found prior art. The new interpretations are presented above.

6. Applicant's arguments with respect to the applicability of Itoh et al have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

GP
Gregory Pickett
Examiner
March 10, 2003



Mickey Yu
Supervisory Patent Examiner
Group 3700